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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
(SAN JOSE DIVISION)

FINJAN LLC, a Delaware Limited Liability
Company,

Plaintiff,

v.

SONICWALL, INC., a Delaware Corporation,

Defendant.

Case No. 5:17-cv-04467-BLF (VKD)

**PLAINTIFF FINJAN LLC'S MOTION TO
PRECLUDE TRIAL TESTIMONY
RELATING TO WRITTEN
DESCRIPTION**

Date: June 24, 2021

Time: 9:00 a.m.

Judge: Hon. Beth Labson Freeman

Dept: Courtroom 3, Fifth Floor

**REDACTED VERSION OF DOCUMENT FILED
UNDER SEAL**

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I. NOTICE OF MOTION

NOTICE IS HEREBY GIVEN that on June 24, 2021, at 9:00 a.m. PT or as soon as counsel may be heard by the Honorable Beth Labson Freeman, Plaintiff Finjan LLC (“Finjan”) will and hereby does move for an order precluding certain trial testimony from Aviel Rubin, Ph.D.; Kevin Almeroth, Ph.D.; and Patrick McDaniel, Ph.D. (together, “the SonicWall Technical Experts”).

II. STATEMENT OF RELIEF BEING SOUGHT AND THE ISSUE TO BE DECIDED

Finjan seeks an order precluding Drs. Rubin, Almeroth, and McDaniel from presenting at trial any opinions that any asserted patent lacks sufficient written description for its asserted claims, and/or that any asserted patent is invalid for that reason. The issue to be decided is whether the SonicWall Technical Experts’ opinions on this issue comport with controlling law requiring that the written description inquiry apply the claims as construed by the court, and not alternative constructions purportedly gleaned from infringement contentions.

III. STATEMENT OF THE RELEVANT FACTS

A. Nature and Stage of the Case

This is a patent case. Finjan accuses Defendant SonicWall, Inc. (“SonicWall”) with infringing eight Finjan patents. Discovery in this case closed in October 2020, and the Court has scheduled trial to begin on May 3, 2021.

B. The Written Description Opinions of SonicWall’s Technical Experts are Based on Alternative Claim Constructions Purportedly Drawn from Finjan’s Infringement Allegations, Not the Court’s Constructions

In September 2020, SonicWall’s counsel served expert reports from each of the SonicWall Technical Experts. Each of these reports contains opinions about the sufficiency of the written description supporting Finjan’s claims.¹ Each of these opinions applies the same basic

¹ Exhibits (“Exh.”) are attached to the Declaration of Robert Courtney in Support of Finjan’s Motion to Preclude Trial Testimony Relating to Written Description. The Rubin report addressed

1 methodology of using Finjan's infringement contentions, rather than this Court's claim
 2 constructions, as the basis for the written description analysis of each patent. The SonicWall
 3 Technical Experts' methodology has four steps:

- 4 1. Identifying an infringement contention by Finjan against a
 5 SonicWall product or functionality;
- 6 2. Based on Finjan's contention, forming an alternative
 7 construction of a claim limitation(s);
- 8 3. Reasoning that Finjan would have adopted this alternative
 9 construction; then
- 10 4. Stating an opinion as to whether the written description
 11 teaches or suggests an embodiment conforming to the
 12 alternative claim construction.

13 All three SonicWall Technical Experts employed this infringement-focused methodology
 14 in all their 112 analyses. *See* Exh. A at 212–40; Exh. B at 253–86; Exh. C at 128–41.

15 The Opening Rubin report's treatment of one limitation from the '408 patent represents the
 16 SonicWall technical experts' general approach. (*See* Exh. A at 212–40.) It begins by analyzing
 17 Finjan's infringement contentions. (*Id.* at 212 ("Finjan contends this claim language is met . . .
 18 .").) The Report then discusses some of the operational details of the SonicWall accused products
 19 and Finjan's infringement allegations against them. (*Id.* at 212–14.) The Report hypothesizes that
 20 one basis for those allegations might have been an alternative interpretation of the '408 claim term
 21 "an incoming stream of programming code" such that the term would cover "[REDACTED]
 22 [REDACTED]." (*Id.* at 213.) The Report assigns this hypothetical construction to
 23 Finjan, though it cites neither any filing by Finjan adopting that construction, nor the Court's
 24 U.S. Patents 8,225,408; 7,975,305; 7,613,926; and 6,965,968. The Almeroth report addressed
 25 U.S. Patents 6,154,844 and 8,141,154. The McDaniel report addressed U.S. Patents 8,677,494
 26 and 6,804,780. Excerpts from these reports are attached as Exhs. A, B, and C, respectively.
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 28

C. At Deposition, SonicWall's Technical Experts Confirmed Their Reliance on Alternative Claim Constructions Derived From Infringement Allegations

Dr. Rubin confirmed that under the proper construction of the claims, he was “not challenging” written description. (Exh. D 50:11–18 [REDACTED])

_____). He confirmed that his written description opinions were based entirely on constructions that the Court has not adopted, and would apply only if the Court “_____” (*Id.* at 46:9–47:1.)

² While there are intermittent citations to the Claim Construction Order in the reports' written description analysis, the analysis primarily relies on Finjan's infringement contentions, and only secondarily (at best) on the Court's claim constructions.

1 **Dr. Almeroth** described his written description argument as a “conditional” argument, and
 2 that he was not providing a written description opinion under “the proper” interpretation of the
 3 claims. (Exh. E 62:22–63:2, 64:13–19.) His analysis was expressly “predicated based on a claims
 4 scope” that he purportedly discerned from Finjan’s “infringement allegations.” (*Id.* at 67:8–15.)

5 **Dr. McDaniel** confirmed that he—like all the SonicWall experts—was applying a
 6 different claim construction for written description than he applied to either infringement or other
 7 aspects of invalidity. (Exh. F 54:12–21 (describing how his written description discussion
 8 “_____”).) And, like the other
 9 experts, he offered no written description opinion under the claim construction actually entered by
 10 the Court. (*Id.* at 55:16–20.)

11 **IV. ARGUMENT**

12 The opinions concerning written description in the SonicWall Technical Experts’ reports
 13 are expressly based on alternative claim constructions crafted by the SonicWall Experts from
 14 Finjan’s infringement allegations. Such methodology is improper as a matter of law, *per se*
 15 unreliable, and improper for consideration by the jury. The Court should not permit SonicWall to
 16 confuse the jury with opinion testimony based on alternative claim constructions prepared by
 17 SonicWall and never adopted by the Court or by Finjan. Because the same fundamental
 18 methodological defect applies across the written description analysis of all SonicWall Experts, the
 19 Court should enter an order precluding those experts from presenting opinions at trial concerning
 20 the sufficiency of written description for any patent-in-suit. The jury should only be presented
 21 with one set of claim constructions: those in the Court’s Claim Construction Order.

22 **A. Legal Standards**

23 **Evidentiary standards.** As the Court knows, Rule 702 bars qualified experts from
 24 presenting to the jury opinions that are not the “product of reliable principles and methods,” or
 25 where the record indicates a failure by the expert to “reliably appl[y] the principles and methods to
 26 the facts of the case.” Fed. R. Evid. 702(c), (d). Rule 703 bars experts from basing their opinions
 27
 28

on facts or data other than those that experts in the field would “reasonably rely on.” Fed. R. Evid. 703.

In the Ninth Circuit, as throughout the U.S., “[t]he trial judge must perform a gatekeeping function to ensure that the expert’s proffered testimony is both reliable and relevant.” *United States v. Redlightning*, 624 F.3d 1090, 1111 (9th Cir. 2010). A district court “may exclude evidence that is based on unreliable principles or methods, [or] legally insufficient facts or data.” *Summit 6, LLC v. Samsung Elecs. Co.*, 802 F.3d 1283, 1295 (Fed. Cir. 2015). Where the expert, or the party proffering the expert’s testimony, is unable to “justif[y] the application of a general theory to the facts of the case,” the affected testimony should be excluded. *Uniloc USA, Inc. v. Microsoft Corp.*, 632 F.3d 1292, 1316 (Fed. Cir. 2011).

Additionally, under Rule 403 evidence is excludable if its “probative value is substantially outweighed” by the risk of “unfair prejudice, confusing the issues, [or] misleading the jury.” Fed. R. Evid. 403; *see also Coleman v. Home Depot, Inc.*, 306 F.3d 1333, 1343 (3d Cir. 2002) (“[E]vidence may be excluded if its probative value is not worth the problems that its admission may cause[.]”).

Standards for claim interpretation. The Supreme Court has long held that patent claim interpretation is an issue of law, to be resolved exclusively by the court. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 372 (1996). In jury trials, the court supplies its constructions to the jury via instructions. *E.g., Every Penny Counts, Inc. v. American Express Co.*, 563 F.3d 1378, 1383 (Fed. Cir. 2009) (“[T]he court’s obligation is to ensure that questions of the scope of the patent claims are not left to the jury.”) Claim interpretation is not, in any sense, a jury issue. *Id.* Courts construing patent claims give terms the meaning they would have to a person of ordinary skill in the art at the time of the invention in view of the specification and the prosecution history. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc).

Standards for assessing the sufficiency of a patent’s written description. The Patent Act requires that each patent contain a sufficient written description “as to enable any person skilled in the art . . . to make and use the same[.]” 35 U.S.C. § 112, ¶ 1. Specifically, the

description must “clearly allow persons of ordinary skill in the art to recognize that the inventor invented what is claimed.” *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc) (quote marks omitted). “[T]he test for sufficiency is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Id.* The sufficiency of written description is evaluated based on “the four corners of the specification.” *Id.* A patent satisfies the written description requirement where its specification is adequate “to support the full scope of the claims as construed [by the court].” *Energy Trans. Grp. v. William Demant Holding A/S*, 697 F.3d 1342, 1350 (Fed. Cir. 2012). Fact-finders evaluating the sufficiency of a patent’s written description apply a presumption that the description is sufficient. A patent may be invalidated on written description grounds only upon clear and convincing evidence that the full scope of the claims, using the construction assigned by the court, lacks support in the written description. *Ariad*, 598 F.3d at 1354.

B. The Opinions’ Methodology of Comparing the Patents’ Disclosures to Alternative Claim Constructions Derived From Infringement Allegations is Improper Under *Daubert* and Rule 702

The written description opinions offered by Drs. Rubin, Almeroth, and McDaniel are inadmissible under *Daubert* due to their use of alternative claim constructions (purportedly drawn from Finjan’s infringement allegations) instead of constructions approved by the Court. That approach is improper as a matter of law, and for each of the SonicWall Experts it led to a distorted, unreliable methodology. Instead of comparing each patent’s construed claims with its description as the law requires, the SonicWall Experts compared Finjan’s infringement allegations (and hypothetical claim constructions derived therefrom) to try and find an embodiment in the patent that exactly matched what was alleged to satisfy those limitations. There is no legal support for such an approach, particularly in the context of a presentation to a jury.

For a written description inquiry (as for any other inquiry into the validity of a patent claim), claims are interpreted according to their ordinary meaning at the time of the invention, in

view of the specification and the prosecution history. *Koninklijke Philips Elecs. N.V. v. Cardiac Sci. Operating Co.*, 590 F.3d 1326, 1336 (Fed. Cir. 2010) (“A district court must base its analysis of written description . . . on proper claim construction.”); *see also Phillips*, 415 F.3d at 1312–13. District courts typically provide that interpretation via pre-trial claim construction proceedings in which the parties are instructed to bring interpretive disputes forward and have them resolved, as was done here. (*See* Claim Constr. Order (Mar. 26, 2019), D.I. 132.) During that process, post-patent documents—such as infringement contentions—that are “not contemporaneous with the patent” and that do not help establish what claim terms meant at the time of the invention, are “not considered.” *Brookhill-Wilk I, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1299 (Fed. Cir. 2003). For more than thirty years the Federal Circuit has specifically reminded litigants, “A claim is construed in light of the claim language, the other claims, the prior art, the prosecution history, and the specification, **not** in light of the accused device.” *SRI Int’l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1118 (Fed. Cir. 1985) (en banc).

The written description opinions here contravene such law because the opinions employ claim constructions that the SonicWall Experts did not receive from the Court, and did not derive from the specification or prosecution history. The alternative constructions on which the SonicWall Experts based their opinions were purportedly gleaned from Finjan’s infringement allegations, which post-date the patents by years. None of the SonicWall Experts contend that the infringement allegations are valid claim construction evidence, yet all of them rely on them for that purpose. Dr. Rubin confirmed that his written description opinions could apply only if the Court adopts those constructions—which it has not done. (Exh. D at 46:9–47:1.) Dr. Almeroth stated that his analysis was discerned from Finjan’s “infringement allegations,” and that he had no written description opinion under “the proper” (i.e., the Court’s) interpretation of the claims. (Exh. E 62:22–63:2, 64:13–19, 67:8–15.) Dr. McDaniel confirmed that but for considering the allegations, he had no other opinion as to written description, and was basing his opinions on “what Finjan appeared to be arguing.” (Exh. F at 54:12–21, 55:16–20.) However *SRI*, *Brookhill-Wilk I*, and *Phillips* make the SonicWall Experts’ error abundantly clear. Finjan’s infringement

contentions are *not a cognizable source of evidence for claim construction*. Using Finjan’s infringement allegations as a source for alternative claim constructions is improper as a matter of law, and *per se* unreliable under *Daubert*.

Finjan is unaware of any authority endorsing an expert applying alternative constructions, derived on the expert’s own recognizance and adopted by neither the Court nor any party, in jury testimony. The Federal Circuit has expressly reminded district courts to be vigilant against attempts to make claim construction a jury issue, which would be the ultimate effect of such testimony. *Every Penny Counts*, 563 F.3d at 1383 (Fed. Cir. 2009) (“[T]he court’s obligation is to ensure that questions of the scope of the patent claims are not left to the jury.”). And it has noted that failure to sufficiently protect the jury may be grounds for reversal. In its words, “The risk of confusing the jury is high when experts opine on claim construction before the jury[.]” *CytoLogix Corp. v. Ventana Medical Sys., Inc.*, 424 F.3d 1168, 1172 (Fed. Cir. 2005).

The written description opinions offered by the SonicWall Experts are fundamentally flawed in their methodology. Tendering invalidity theories based on alternative claim constructions that are (1) unendorsed by the Court, and (2) expressly derived from documents that are not cognizable claim construction evidence is improper as a matter of law and *per se* unreliable from the standpoint of expert methodology. Under *Daubert*, the Court should enter an order precluding SonicWall from offering such testimony at trial. Because it is not disputed that none of SonicWall’s experts have disclosed any written description opinions except those based on the infringement allegations (and the hypothetical claim constructions derived therefrom), the Court should order that SonicWall may not present any expert opinion at trial on written description.

C. The Opinions Are Additionally Inadmissible Under Rule 403 Because They are Non-Probative and Would Promote Confusion About the Claim Constructions the Jury Must Apply During Fact-Finding

Even if the SonicWall Experts’ methodology of using alternative claim constructions rather than court-endorsed ones were permissible under *Daubert* (it is not), it would still be inadmissible due to the plain lack of probative value and clear risk of jury confusion. As to their

probative value, it is well established that courts have the sole responsibility (and obligation) to resolve claim construction disputes. *E.g., O2 Micro Int'l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1362 (Fed. Cir. 2008). Testimony by a SonicWall expert hypothesizing that the claim constructions might have been different than those the court has entered would not be probative of any claim or defense in the case. And as to confusion, as already noted, “the risk of confusing the jury is high when experts opine on claim construction before the jury[.]” *CytoLogix Corp. v. Ventana Medical Sys., Inc.*, 424 F.3d 1168, 1172 (Fed. Cir. 2005). Because the SonicWall Experts’ opinions use alternative constructions the Court has not endorsed, there is a significant risk that the jury would become confused as to which construction should be used in the various portions of the case. Further, presentation of these opinions would even threaten to make the jury incapable of filling out its critical fact-finding role. Because the SonicWall Experts’ opinions are based on disputed claim constructions, it would be impossible for any jury to evaluate the credibility of those opinions without evaluating the credibility of the constructions. But as already discussed, claim construction is outside the jury’s role. *E.g., Every Penny Counts*, 563 F.3d at 1383. The jury would thus be unable to carry out their duty to assess credibility without at the same time exceeding their role by reviewing claim construction. This situation would be deeply unfair to Finjan, as the party seeking to maintain the Court’s constructions rather than venture into hypothetical alternate constructions.

It was precisely to avoid this circumstance that the Supreme Court confirmed courts’ sole responsibility for claim construction. *Markman*, 517 U.S. at 372. The Court should reaffirm that role here, and protect the jury from near-certain confusion, by rejecting SonicWall’s attempt to make claim construction a jury issue. If it does not preclude the SonicWall written description opinions under *Daubert*, it should preclude them as prejudicial and non-probative under Rule 403.

V. CONCLUSION

For the reasons given, Finjan respectfully moves that the Court enter an order precluding SonicWall from presenting at trial unreliable expert testimony concerning alleged insufficiency of written description for any of the asserted patents.

1 Dated: January 21, 2021

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CERTIFICATE OF SERVICE

21 The undersigned hereby certifies that a true and correct copy of the above and foregoing
22 document has been served on January 21, 2021, to all counsel of record who are deemed to have
23 consented to electronic service via the Court's CM/ECF system. Any other counsel of record will
24 be served by electronic mail and regular mail.

/s/ Robert Courtney

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